

REMARKS**1. Specification Amendments.**

The Specification has been amended to place trademarks in all capital letters followed by the appropriate symbol and generic terminology. No new matter has been added.

2. Claims Amendments.

The claims have been reviewed and amended for clarity.

Applicant submits that these clarifications address the examiner's 35 USC 112 and 103 concerns and Applicant requests that the examiner withdraw the rejections.

Claim 1 has been amended to indicate the purpose of the formulation. Support for this amendment can be found on page 9, lines 6-11 of the Specification. No new matter has been added.

Claim 2 has not been amended in this response.

Claim 3 has been amended to indicate that the substrate is a canvas. Support for this amendment can be found on page 4, lines 20-23 of the Specification. No new matter has been added.

Claims 4-7 have not been amended in this response.

Claim 8 has been amended to indicate that the final coating is created by mixing the paint mixture with a water soluble polymer. Support for this amendment can be found on page 5, lines 14-22 of the Specification. No new matter has been added.

Claim 9 has been amended to indicate the purpose of the formulation (support for this amendment can be found on page 9, lines 6-11 of the Specification) and to indicate that the final coating is created by mixing the paint mixture with a water soluble polymer (support for this amendment can be found on page 5, lines 14-22 of the Specification). No new matter has been added.

Claim 10 has been amended to indicate that the water soluble polymer is selected from the group consisting of polyvinyl alcohol, polyethylene oxide, cellulose and its derivatives, polyvinyl pyrrolidone, starch, animal hide glue, gum Arabic, xanthan gum and guar gum. Support for this amendment can be found on page 6, lines 29-32. No new matter has been added.

Claims 11 and 12 have not been amended in this response.

Claim 13 has been amended to indicate that the water soluble polymer is added to the paint mixture at a ratio of 1 to 30 weight percent based on the weight of solids in the paint mixture. Support for this amendment can be found on page 6, lines 1-5 of the Specification. No new matter has been added.

Claim 14 has been amended to indicate the purpose of the formulation. Support for this amendment can be found on page 9, lines 6-11 of the Specification. No new matter has been added.

Claim 15 has been amended to indicate that the final coating is created by mixing the paint mixture with a water soluble polymer. Support for this amendment can be found on page 5, lines 14-22 of the Specification. No new matter has been added.

Claims 16 and 17 have not been amended in this response.

Claim 18 has been amended to indicate that the final coating is created by mixing the paint mixture with a water soluble polymer (support for this amendment can be found on page 5, lines 14-22 of the Specification) and to indicate that the water soluble polymer is added to the paint mixture at a ratio of 1 to 30 weight percent based on the weight of solids in the paint mixture (support for this amendment can be found on page 6, lines 1-5 of the Specification). No new matter has been added.

Claim 19 has been amended to indicate the purpose of the formulation (support for this amendment can be found on page 9, lines 6-11 of the Specification) and to indicate that the final coating is created by mixing the paint mixture with a water soluble polymer (support for this amendment can be found on page 5, lines 14-22 of the Specification). No new matter has been added.

Claim 20 has been amended to indicate that the water soluble polymer is selected from the group consisting of polyvinyl alcohol, polyethylene oxide, cellulose and its derivatives, polyvinyl pyrrolidone, starch, animal hide glue, gum Arabic, xanthan gum and guar gum. Support for this amendment can be found on page 6, lines 29-32. No new matter has been added.

Claims 21 and 22 have not been amended in this response.

Claim 23 has been amended to indicate that the final coating is created by mixing the paint mixture with a water soluble polymer (support for this amendment can be found on page 5, lines 14-22 of the Specification) and to indicate that the

water soluble polymer is added to the paint mixture at a ratio of 1 to 30 weight percent based on the weight of solids in the paint mixture (support for this amendment can be found on page 6, lines 1-5 of the Specification). No new matter has been added.

No new matter has been entered in any of these amendments.

3. Claims 1-23 Are Not Obvious Under 35 USC 103 Over Iguchi '132 In View Of Kronzer '086.

Claims 1-23 have been rejected under 35 USC 103 as being obvious over US Patent 5838132 to Iguchi (Iguchi '132) in view of US Patent No. 6703086 to Kronzer (Kronzer '086).

For a claim to be determined obvious (or nonobvious) under 35 USC 103, the claimed material must have been obvious to person of ordinary skill in the art from the prior art. An obviousness determination requires examining (1) the scope of the prior art, (2) the level of skill in the art, and (3) the differences between the prior art and Applicant's invention. *Litton Systems, Inc. v. Honeywell, Inc.*, 117 SCt 1270 (1970). A mere suggestion to further experiment with disclosed principles would not render obvious an invention based on those principles. *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 19 USPQ2d 1432 (Fed. Cir. 1991). In fact, an applicant may use a reference as his basis for further experimentation and to create his invention. *Id.*

The fact that each element in a claimed invention is old or unpatentable does not determine the nonobviousness of the claimed invention as a whole. *See Custom Accessories, Inc., v. Jeffrey-Allan Industries*, 1 USPQ2d 1196 1986 (Fed. Cir. 1986). The prior art must not be given an overly broad reading, but should be read in the context of the patent specifications and **as intended by reference authors**. *Durling v. Spectrum Furniture Co.*, 40 USPQ2d 1788 (Fed Cir 1996) (Federal Circuit held that district court erred by giving a "too broad an interpretation" of claims in a sofa patent to invalidate another on the nonobviousness standard).

The Federal Circuit has defined and determined the bounds of the prior art to be identical for both nonobviousness and anticipation purposes. *See In re Lowry*, 32 USPQ2d 1031 (Fed. Cir. 1994). Prior art for these purposes is pertinent art recognized by persons of ordinary skill to be in the **field of the invention**. *See In re Spada* 15 USPQ2d 1655, 1657 (Fed.Cir.1990), *In re Horne*, 203 USPQ 969, 971

(CCPA 1979). Prior art is pertinent if persons of ordinary skill in the art would have consulted art in that field to develop the invention given the nature of the problem. *See In re Paulsen*, 31 USPQ2d 1671 (Fed. Cir. 1994). Specifically, the pertinence of any reference is dependent upon whether it would suggest to persons skilled in the art to do the thing that the applicant has done, and the same is true in considering more than one reference or a reference alleged not to be in the particular art. *See In re Phipps*, 69 USPQ 88 (CCPA 1946). Nonanalogous prior art cannot properly be considered prior art under 35 USC 103. *In re Pagliaro*, 210 USPQ 888, 892 (CCPA 1981).

The Federal Circuit has made it clear that the nonobviousness standard is applied wrongly if a court or an examiner: (1) improperly focuses on "a combination of old elements" rather than the invention as a whole; (2) ignores objective evidence of nonobviousness; (3) pays lip service to the presumption of validity; and (4) fails to make sufficient *Graham* findings. *Custom Accessories, Inc.*, 1 USPQ2d 1196 (Fed. Cir. 1986). Applying the nonobviousness test counter to these principles counters the principle that a patent application is presumed nonobvious. *Id.*

To sustain a rejection under 35 USC 103, the examiner must establish a *prima facie* case of obviousness. MPEP §2142. To establish a *prima facie* case of obviousness, the prior art reference (or references when combined) must teach or suggest all the claim limitations. MPEP §2143. This just is not the case with the present invention. As the present invention is not fairly taught by or related to the subject matter of the cited prior art, it cannot and does not make obvious the present invention as claimed, and Applicant requests that this ground for rejection be withdrawn.

Initially, Iguchi '132 teaches the use of a gas phase silica and is used for producing a separate ink jet layer on a pigment layer. The present invention does not incorporate a gas phase silica and is a single layer. These distinctions alone make the present invention patentably distinct from Iguchi '132 and Iguchi '132 in combination with Kronzer '086. Further, however, the amendments to the claims to clarify that the paint mixture is combined with a water soluble polymer further differentiates the present invention from the cited art.

Iguchi '132 teaches an ink jet recording sheet that can give an image having an appearance looking like a picture, especially, an oil painting with maintaining sufficient print density. The ink jet recording sheet comprises a fabric support and an

ink receiving layer provided on one side of the support, where the surface of the ink receiving layer has an arithmetical mean roughness of not more than 30 μm measured in accordance with JIS B0601. The ink receiving layer is coated on a pigment layer that itself is coated on at least one side of the fabric or on at least one side of the fabric impregnated with a pigment component. The surface of the ink receiving layer preferably has a 75° specular gloss of not less than 10 measured in accordance with JIS P8142. The fabric is preferably a woven fabric comprising yarns having a diameter of not less than 200 μm . The ink receiving layer preferably contains a gas phase method silica, preferably having an average primary particle diameter of 3-40 nm and a specific surface area of not less than 50 m^2/g measured by BET method. Iguchi '132 further discloses a method for producing an ink jet recording sheet that comprises calendering a fabric coated with a pigment layer on at least one side or impregnated with a pigment component and then coating an ink receiving layer on the pigment layer or on one side of the fabric impregnated with the pigment component.

The only independent claim of Iguchi '132 requires:

1. An ink jet recording sheet comprising a support and an ink receiving layer provided on one side of the support, the support being a fabric and having a pigment layer on at least the side on which the ink receiving layer is provided or is impregnated with a pigment component, wherein the fabric is a woven fabric comprising yarns having a diameter of 100-1,000 μm and the surface of the ink receiving layer has an arithmetical mean roughness of not more than 30 μm measured in accordance with JIS B0601.

Iguchi '132 is based on replicating oil painting and discloses printing an oil painting using the ink recording sheet such that an image looking like the oil painting can be obtained without subjecting to other treatments after printing. To this end, Iguchi '132 teaches the use of various means for imparting a special gloss to the coating by using microfine particles as the pigment in the ink receiving layer (for example, alumina hydrate, gas phase method silica, etc.) and carrying out a surface treatment using a calender such as machine calender, super calender, or soft-calender, and others. Additionally, Iguchi '132 requires a mean roughness of a certain level.

Such treatments teach away from the present invention, in which no special surface gloss or treatment, or mean roughness, is necessary for the production of

watercolor works of art and the like suitable for the present invention. In fact, those of skill in the art know that oil painting and watercolor painting require different materials and techniques and would not look to the oil painting field for inspiration in the watercolor field.

Kronzer '086 teaches a printable material that includes a flexible first layer having first and second surfaces and a second layer. The first layer may be a film or a cellulosic nonwoven web. The second layer overlays and is bonded to the first surface of the first layer and includes a nonwoven web. The first layer has a basis weight of from about 20 to about 140 g/m². The thermoplastic polymer has a melting point of from about 90°C to about 250°C and the second layer has a basis weight of at least about 10 g/m². The first layer may be a cellulosic nonwoven web, such as a latex-impregnated paper. The second layer may be thermally bonded to the first layer or bonded by an adhesive. A release layer may be present between the first layer and the heat-activated adhesive. The second layer may contain from about 0.1 to about 20 percent by weight, based on the weight of the second layer, of a material which increases the viscosity of an ink jet ink when printed on the second layer. The second layer also may contain from about 0.1 to about 5 percent by weight, based on the weight of the second layer, of a cationic polymer. When the second layer is prepared from a thermoplastic polymer, the ink jet printable material may be used as a heat transfer material.

Kronzer '086 teaches the use of latex as a coating on a support layer that receives ink. Kronzer '086 does not specifically teach the percentages in the instant claims. Further, neither of the cited patents discloses nor even hint to using a coated canvas for watercolor paints, both of the cited patents disclosing ink printer substrates.

The main independent claim of Kronzer '086 requires:

1. An ink jet printable material comprising:
 - a flexible first layer having first and second surfaces, the flexible first layer being a film or a cellulosic nonwoven web having a basis weight of from about 20 to about 140 grams per square meter; and
 - an ink receptive second layer having first and second surfaces, the first surface being ink printable with a printer and the second surface being overlaid and bonded to the first surface of the first layer, which second layer comprises a nonwoven web having a basis weight of at least 10 grams per

square meter formed from a natural or synthetic polymer, and which second layer contains from about 0.1 to about 20 percent by weight, based on the weight of the second layer, of a material which increases the viscosity of an ink jet ink when printed on the second layer.

As can be seen, Kronzer '086 is for a material that is "ink printable with a printer", which is not a requirement of the present invention. In addition, Applicant submits that there is no motivation to combine the teachings of the cited prior art and that, in fact, both Iguchi '132 and Kronzer '086 teach away from each other and the present invention.

Additionally, it does not appear that either Iguchi '132 or Kronzer '086 teach the mixing of a paint mixture comprising from 100-200 parts by weight water-based latex, 0-5 parts by weight pigment dispersant, 0-2 parts by weight defoamer, 75-150 parts by weight pigment and filler, 0-50 parts by weight extender, 0-5 parts by weight surfactant, and 0-50 parts by weight water, with a water soluble polymer at a ratio of 1 to 30 weight percent based on the weight of solids in the paint mixture to create the coating. Further, it does not appear that Iguchi '132 or Kronzer '086 teach the use of such a coating to accept water-based paints, pencils, and inks without unacceptable running or bleeding of the water-based paints, pencils, and inks in and on the coating, and to allow the removal of the water-based paints, pencils, and inks from the coating without harming the coating by wetting the coating and wiping off the water-based paints, pencils, and inks.

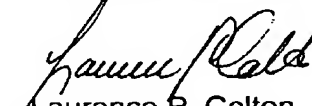
Accordingly, Applicant submits that the cited art does not obviate Claims 1-23, there was no motivation to combine the cited art in the manner suggested by the examiner, and that even if the cited art can be combined, they fail to teach or obviate the present invention. Applicant requests that the examiner reconsider and withdraw this rejection.

CONCLUSION

Applicant submits that the patent application is in proper condition for allowance, and respectfully requests such action.

If the Commissioner or the Examiner has any questions that can be resolved over the telephone, please contact the below signed patent attorney of record.

Respectfully submitted,
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